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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/047,030	03/24/98	COTICHINI	C

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EXAMINER	
DALENCOURT, Y	
ART UNIT	**PAPER NUMBER**
2735	10

DATE MAILED: 08/15/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.	Applicant(s)
09/047,030	Cotichini et al
Examiner	**Group Art Unit**
Yves Dalencourt	2735

☒ Responsive to communication(s) filed on *May 15, 2000*.

☒ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire *3* month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) *1-94* is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) *1-94* is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐approved ☐disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). *9*

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

DETAILED ACTION

This action is responsive to amendment filed on 05/15/2000.

Drawings

1. This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

Response to Amendment

The examiner has acknowledged the amended claims 1, 2, 48 - 51, and 86 - 89.

Response to Arguments

2. Applicant's arguments filed on 05/15/2000 have been fully considered but they are not persuasive.

Regarding applicant's arguments (page 6, first paragraph), the examiner maintains that the non-statutory double patenting rejetion is proper.

Regarding applicant's arguments (page 7, second paragraph), the examiner has withdrawn the rejection of claims 1 - 94 as being obvious over Sheffer and Wesinger.

Regarding applicant's arguments (page 10, first paragraph), the examiner has withdrawn the 102(e) rejection. However, a new rejection under 35 U.S.C. 102 (g)/(f) has been applied to claims 1 - 94 since this application and US patent number 5,802,280 have different inventors).

Double Patenting

3. Claims 1 - 3, 7, 8, 12, 17, 20 - 26, 29 - 32, 37 - 40, 42 - 47, 56, 57, 61 - 64, 74 - 78, and 80 - 85 are rejected under the judicially created doctrine of double patenting over claims 1 - 13 of U. S. Patent No. 5802280 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows:

Regarding claims 1 - 3, 37 - 38, 42, 57, a method for tracing a electronic device having an agent initiating communication and providing identifying indicia to a host system, said electronic device connectable to said host system through a global network (**see preamble of claim 1 of patent '280**), said method comprising the steps of automatically providing said host system with said identifying indicia through said global network for determining the identity of said electronic device (**claims 1 and 7 of patent '280**); and providing said host system with one or more of the global network communication links used to enable transmission between said electronic device and said host system, said transmission via said communication links used for determining the location of said electronic device (**claim 1 of patent '280**).

Regarding claims 7 and 40, the method of claims 3 and 38 wherein the step of providing said host system with said identifying indicia through said global network, and said step of providing said identifying indicia to said host system through said telephone network occur at a predetermined intervals (**claim 5 of patent '280**).

Regarding claim 8, the method of claim 7 wherein said electronic device is lost or stolen and said method further including the step of tracing lost or stolen electronic devices (**claim 1 of patent '280**).

Regarding claim 17, the method of claim 1 wherein said electronic device is a computer having a hard drive (**claim 3 of patent '280**).

Regarding claims 20, 31, 39, the method of claims 1 and 37 wherein said step of evading detection is accomplished by providing an agent which is operable without interfering with the normal operation of said electronic device (**claim 7 of patent '280**).

Regarding claim 32, the method of claim 31 wherein the step of providing said host system with said identifying indicia occurs without causing audible or visible signals to be emitted from said electronic device (**claim 8 of patent '280**).

Regarding claim 43, the method of claim 1 wherein the agent is encoded in one or more forms, including software, firmware and hardware (**claim 9 of the patent '280** explicitly mentions that an agent is disposed on the ROM BIOS non-volatile memory of said electronic device for initiating communication with said host system). Based on that claim 43 is rejected.

Regarding claim 44, the method of claim 43 wherein the agent is encoded in one or more device components in the electronic device, including internal non-volatile memory device, communication device, processor, digital signal processor, integrated circuit and hardware circuit. Claim 44 is rejected for the same reason in claim 43.

Regarding claim 45, the method of claim 44 wherein the internal non-volatile memory device includes one of ROM BIOS, ROM, EPROM, EEPROM, and Flash ROM. Claim 45 is rejected for the same reason in claim 43.

Regarding claim 46, the method of claim 44 wherein the communication device is a modem (**claim 4 of patent '280**).

Regarding claim 47, the method of claim 46 wherein the Agent establishes communication with the host system by using a command function which initializes the communication and a call management function which interfaces with the host system (**claim 9 of patent '280** recites means for establishing an interface.....said host system which implicitly involves an initialization function and a management function. Therefore, it would have been obvious to one skilled in the art to have interpreted this limitation in order to make the limitation of claim 47 obvious. Based on that claim 47 is rejected.

Claims 56, 57, 61 - 64, 74 - 78, and 80 - 85 are drawn to substantially the same limitations as claims 1 - 3, 7, 8, 12, 17, 20 - 26, 29 - 32, 37 - 40, 42 - 47 are rejected for the same reason.

Furthermore, there is no apparent reason why applicant was prevented from presenting

claims corresponding to those of the instant application during prosecution of the application which matured into a patent.

4. Claims 1, 2, 8, 9, 11, 13 - 17, 20 - 26, 31, 33 - 34, 37 - 39, 41 - 56, 61 - 65, 68 - 71, and 73 - 94 are provisionally rejected under the judicially created doctrine of double patenting over claims 1 - 47 of copending Application No. 08/871,221. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows:

Regarding claims 1,8, 20, 13, 37 - 39, 57, and 63, a method for tracing a electronic device having an agent initiating communication and providing identifying indicia to a host system, said electronic device connectable to said host system through a global network; said method comprising the steps of automatically providing said host system with said identifying indicia through said global network for determining the identity of said electronic device; and providing said host system with one or more of the global network communication links used to enable transmission between said electronic device and said host system, said communication links used for determining the location of said electronic device (**claim 1 of application No. 08/871,221**).

Regarding claim 2, the method of claim 1, wherein said global network is the network **(claim 44 of application No. 08/871,221)**.

Regarding claim 9, the method of claim 2, wherein said step of providing said host system with said one or more of the Internet communication links is accomplished using a traceroute routine **(claim 46 of application No. 08/871,221)**.

Regarding claim 11, the method of claim 2, wherein said step of providing said host system with said identifying indicia is accomplished by sending a domain name service query with said identifying indicia encoded therein **(claim 45 of application No. 08/871,221)**.

Regarding claim 17, the method of claim 1, wherein said electronic device is a computer having a hard drive **(claim 14 of application No. 08/871,221)**.

Regarding claim 26, the method of claim 17, wherein said step of loading said agent within said computer is accomplished by loading said agent within said computer is accomplished by loading said agent on the ROM BIOS **(claim 18 of application No. 08/871,221)**.

Regarding claim 43, the method of claim 7 or 40, wherein the agent is encoded in one or more forms, including software, firmware and hardware **(claim 2 of application No. 08/871,221)**.

Regarding claim 44, the method of claim 43, wherein the agent is encoded in one or more device components in the electronic device, including internal non-volatile memory device, communication device, processor, digital signal processor, integrated circuit and hardware circuit **(claim 3 of application No. 08/871,221)**.

Regarding claim 45, the method of claim 44 wherein the internal non-volatile memory device includes one of ROM BIOS, ROM, EPROM, EEPROM, and Flash ROM (**claim 4 of application No. 08/871,221**).

Regarding claim 46, the method of claim 44 wherein the communication device is a modem (**claim 5 of application No. 08/871,221**).

Regarding claim 47, the method of claim 46 wherein the Agent establishes communication with the host system by using a command function which initializes the communication and a call management function which interfaces with the host system (**claim 6 of application No. 08/871,221**).

Regarding claim 48, the method of claim 43, wherein the agent establishes communication with the host system independent of instructions from the electronic device (**claim 7 of application No. 08/871,221**).

Regarding claim 50, the method of claim 42, wherein the agent is activated prior to loading the operation system (**claim 8 of application No. 08/871,221**).

Regarding claim 51, the method of claim 50, wherein the agent is activated by loading into an internal volatile memory and running the agent prior to activating the operation system (**claim 9 of application No. 08/871,221**).

Regarding claim 52, the method of claim 50, which comprises the step of checking whether the agent is also found on a hard disk within the electronic device; and copying the agent

to the hard disk prior to loading and running the agent (**claim 10 of application No. 08/871,221**).

Regarding claim 53, the method of claim 44, wherein a first component of the Agent is provided in a first device component and a second component of the Agent is provided in a second device component (**claim 11 of application No. 08/871,221**).

Regarding claim 54, the method of claim 53, wherein the first component of the Agent includes a secure protocol component of the Agent which communicates with the electronic device's operating system (**claim 12 of application No. 08/871,221**).

Regarding claim 55, the method of claim 53, wherein the Agent immediately establishes the communication link with the host system to transmit the identifying indicia of the electronic device if the secure protocol component fails to establish communication with the operating system (**claim 13 of application No. 08/871,221**).

Claims 14 - 16, 21 - 25, 31, 33 - 34, 49, 56, 61, 62, 64 - 65, 68 - 71, and 73 - 94 are drawn to substantially the same limitations as claims 1, 2, 8, 9, 11, 13, 17, 20, 26, 37 - 39, 43 - 48, 50 - 55, 57, and 63 are rejected for the same reason.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application.

5. Claims 1, 3 - 10, 12, 16, 18 - 32, 35 - 40, 44, 46 - 69, 74 - 78, 80, and 82 - 84 are rejected under the judicially created doctrine of double patenting over claims 1 - 47 of U. S. Patent No.

5,764,892 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: **(claims 1, 37, and 57 of Application Number '030 are the same as claims 1, 26 - 28, 30 - 32, and 38 of 'Patent Number '892); (claims 3, and 33 of Application Number '030 are the same as claims 14 and 21 of 'Patent Number '892); (claim 4 of Application Number '030 are the same as claim 22 of 'Patent Number '892); (claims 5 and 6 of Application Number '030 are the same as claims 22 of 'Patent Number '892);(claim 7 of Application Number '030 are the same as claim 21 of 'Patent Number '892);(claim 9 of Application Number '030 are the same as claim 46 of 'Patent Number '892)(claim 15 of Application Number '030 are the same as claim 23 of 'Patent Number '892);(claim 24 of Application Number '030 are the same as claim 28 of 'Patent Number '892); (claim 25 of Application Number '030 are the same as claim 30 of 'Patent Number '892);(claim 26 of Application Number '030 are the same as claim 31 of 'Patent Number '892);(claim 64 of Application Number '030 are the same as claim 7 of 'Patent Number '892);(claim 78 of Application Number '030 are the same as claim 15 of 'Patent Number '892).**

Claims 8 - 10, 12, 16, 18 - 32, 35 - 40, 44, 46 - 63, 65 - 69, 74 - 77, 80, and 82 - 84 are drawn to substantially the same limitations as claims 1, 3 - 7, 15, 24 - 26, 33, 37, 66, and 78 are rejected for the same reason.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (f) he did not himself invent the subject matter sought to be patented.
>
> (g) before the applicant's invention thereof the invention was made in this country by another who had not abandoned, suppressed, or concealed it. In determining priority of invention there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

7. Claims 1 - 8, 10, 17 - 40, 42 - 67, 71 - 76, and 81 - 94, are rejected under 35 U.S.C. 102(f) and 102(g) as being anticipated by Cotichini et al (US 5802280; hereinafter Cotichini).

Regarding claims 1, 8, 17 - 20, 36 - 37, 47, 56 - 57, 61 - 67, 75, 85, and 91 - 94, Cotichini et al teaches a method for tracing a electronic device having an agent initiating communication and providing identifying indicia to a host system, said electronic device connectable to said host system through a global network (col. 2, lines 6 - 11, see abstract), said method comprising the steps of automatically providing said host system with said identifying indicia through said global

network for determining the identity of said electronic device (col. 2, lines 33 - 58, see abstract); and providing said host system with one or more of the global network communication links used to enable transmission between said electronic device and said host system, said transmission via said communication links used for determining the location of said electronic device (col. 2, lines 12 - 22, abstract).

Regarding claims 2, 33 - 34, 65, and 71 - 73, Cotichini et al teach all the limitations but fail to specifically teach a global network which includes Internet. However, the examiner takes official notice that computers use protocols in order to communicate to each other, and which are also used on the Internet. Therefore, the global network of Cotichini et al includes also Internet. Also, telecommunications data are transferred on the same networks used to transfer Internet data.

Regarding claims 3 and 38, Cotichini et al teaches a method for tracing a electronic device having an agent initiating communication and providing identifying indicia to a host system, said electronic device connected to said host system through a telephone network, and comprises the steps of providing said identifying indicia to said host system through said telephone network; and determining the location of said electronic device by tracing the source of said identifying indicia within said telephone network (col. 6, lines 49 - 53).

Regarding claims 4 - 6, and 58 - 60, Cotichini et al does not specifically teach a method for tracing a electronic device having an agent initiating communication and providing identifying indicia to a host system, said electronic device connected to said host system through a

cablevision network, a wireless radio frequency network, and a wireless microwave network. However, one artisan in the art recognizes that using these elements is a matter of design choice depends on the environment (see col. 12, lines 48 - 56). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included a cablevision network, a wireless radio frequency network, and a wireless microwave network in Cotichini et al's device for allowing communication between a remote station and an electronic device.

Regarding claims 7, 40, 42, and 76, Cotichini et al teaches a method for tracing a electronic device having an agent initiating communication and providing identifying indicia to a host system, said electronic device connectable to said host system through a global network which comprises the step of providing said host system with said identifying indicia through said global network, and said step of providing said identifying indicia to said host system through said telephone network occur at a predetermined intervals (col. 2, lines 6 - 11; see abstract).

Regarding claim 10, Cotichini et al teaches a method for tracing a electronic device having an agent initiating communication and providing identifying indicia to a host system, said electronic device connectable to said host system through a global network which comprises the step of providing said host system with said identifying indicia is accomplished by sending a data packet including address information relating to the source of the global network transmission (col. 6, lines 10 - 23).

Regarding claim 17, Cotichini et al and Wesinger, Jr. et al teach all the limitations, and Cotichini et al further teaches an electronic device which is a computer having a hard drive (col. 2, lines 46 - 59 and col. 5, lines 25 - 28).

Regarding claims 21 - 26, Cotichini et al teaches a method which comprises the step of loading said agent within said computer which is accomplished by loading said agent within the boot sector, the partition sector of said hard drive (paragraph bridging between col. 3 & col. 4 and between col. 4 & col. 5).

Regarding claims 27 - 30, Cotichini et al teaches a method for tracing a electronic device having an agent initiating communication and providing identifying indicia to a host system, said electronic device connectable to said host system through a global network which comprises an agent which is a terminated and stay resident program, a virtual device driver program, a file filter program (paragraph bridging between col. 3 & col. 4).

Regarding claims 31, 39, and 63, Cotichini et al teaches a method for tracing a electronic device having an agent initiating communication and providing identifying indicia to a host system, said electronic device connectable to said host system through a global network which comprises an agent which provides said identifying indicia automatically and without user intervention (see claim 7).

Regarding claims 32 and 64, Cotichini et al teaches a method for tracing a electronic device having an agent initiating communication and providing identifying indicia to a host system, said electronic device connectable to said host system through a global network which

comprises the step of providing said host system with said identifying indicia occurs without causing audible or visible signals to be emitted from said electronic device (see claim 8).

Regarding claims 35 and 74, Cotichini et al teaches a method for tracing a electronic device having an agent initiating communication and providing identifying indicia to a host system, said electronic device connectable to said host system through a global network which comprises the step of assigning said identifying indicia to said agent wherein said identifying indicia comprises a unique electronic serial number, said electronic serial number for enabling the determination of the identity of said electronic device associated with said agent (col. 6, lines 55 - 60; see also abstract).

Regarding claims 43 - 46, and 81 - 84, Cotichini et al teaches a method for tracing a electronic device having an agent initiating communication and providing identifying indicia to a host system, said electronic device connectable to said host system through a global network which comprises an agent encoded in one or more forms, including software, firmware and hardware (col. 2, lines 54 - 59 see also claim 1).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. Claims 9, and 11 - 16, 41, 68 - 70, and 77 - 80 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cotichini et al (US 5802280; hereinafter Cotichini) as applied to claim 2, above, and further in view of Wesinger, Jr. et al (US 5778367; hereinafter Wesinger, Jr.).

Regarding claims 9, 11, 15 - 16, 41, 68 - 70, Cotichini et al teaches all the limitations, but fails to specifically teach a method for tracing electronic devices which comprises the step of providing said host system with said one or more of the Internet communication links is accomplished using a traceroute routine.

However, Wesinger, Jr. teaches, in an art related field of identification system, an automated on-line information service and directory, particularly for the world wide web which comprises the step of providing said host system with said one or more of the Internet communication links is accomplished using a traceroute routine (col. 7, lines 18 - 28 and col. 8, lines 15 - 30) for the purpose of obtaining easily information about people on the Internet and their location.

Thus, it would have been obvious to one of ordinary skill in the art at the time the invention made to have included a step of providing said host system with said one or more of the Internet communication links is accomplished using a traceroute routine in Cotichini et al's device as taught by Wesinger, Jr. et al for the purpose of obtaining easily information about people on the Internet and their location.

Regarding claims 12 - 14, 77 - 80, Cotichini et al and Wesinger, Jr. et al teach all the limitations on claim 2, and Cotichini et al further teaches a method step of providing a list of lost or stolen electronic devices to said host system and comparing said list of lost or stolen electronic devices with said identifying indicia to determine if said electronic device is lost or stolen (col. 12, lines 5 - 13).

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yves Dalencourt whose telephone number is (703) 308-8547. The examiner can normally be reached on Monday through Thursday from 7:30AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Horabik, can be reached on (703) 305-4704. The fax phone number for this Group is (703) 305-3988.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-8576.

Yves Dalencourt
Y.D
August 07, 2000

MICHAEL HORABIK
SUPERVISORY PATENT EXAMINER
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